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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,458	03/12/2004	James L. Murtha	P05417US01	7699
22885	7590	06/08/2005	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			HUNTER, ALVIN A	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/799,458

Applicant(s)

MURTHA, JAMES L.

Examiner

Alvin A. Hunter

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-17 is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) 11 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/12/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

The abstract of the disclosure is objected to because Abstract is more than one paragraph. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites, "... an attachment mechanism positioned on the elongated body for detachably holding the golf club shaft of the golf club ..." Does the applicant intend for "golf club shaft" to read --putting aid--? For the purpose of examination, the "golf club shaft" in sentence bridging lines 8 and 9 will be interpreted as --putting aid--.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1, 2, 4, 5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Marshall (USPN 4934706).

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Regarding claim 1, Marshall discloses a training aid comprising an elongated body **36** having longitudinal axis and a first end and second end, a level **34** mounted to the elongated body wherein the level having a longitudinal axis parallel to the elongated body and having a bubble indicator **35**, an attachment mechanism **14** position on the elongated body for holding the device on and perpendicular to the club shaft, and a plurality of calibrations **30** on the elongated body spaced apart from one another (See Figure 3 and 5). Other limitations recited in claim 1, are directed to intended use and therefore, it is submitted that Marshall can inherently perform the same uses (See MPEP 2112).

Regarding claim 2, Marshall discloses the level located adjacent the first end of the elongated member and the attachment mechanism a notch located adjacent the second end of the elongated member (See Figure 3).

Regarding claim 4, Marshall discloses the elongated body having a elongated calibration portion wherein the plurality of calibrations are located (See Figure 3).

Regarding claim 5, Marshall shows the elongated calibration portion parallel to the longitudinal level axis (See Figure 3).

Regarding claim 8, Marshall shows the attachment mechanism being a C-shaped notch in the elongated body having a pair of spaced apart side walls and an inner notch wall and open end sized to receive a club shaft between the walls (See Figure 3 and 4).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall (USPN 4934706).

Regarding claim 3, Marshall does not disclose the attachment member comprising a first and second compressible member for frictional fit. Applicant does not assert any advantages for the compressible members within the specification. Furthermore, applicant notes on page 7, last full paragraph, "Attachment member may be of various constructions without distracting from the invention." Marshall discloses an attachment member having a set screw for attaching the device to the club shaft. One having ordinary skill in the art would have found it obvious to use any type of attachment means, such as a set screw, in order to facilitate attachment of the device to the club shaft.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall (USPN 4934706) in view OFFICAL NOTICE.

Regarding claim 6 and 7, Marshall does not disclose the device having a viewing opening or the level having a transparent tube. OFFICIAL NOTICE is taken that it commonly known for a level to have a transparent tube and a gas bubble. A level usually contains a pigmented liquid in which the gas bubble can be distinguished and view through the transparent tube. One having ordinary skill in the art would have found it obvious to have a level with a transparent tube and gas bubble because of it common accessibility with in the art. One would question why a view opening is necessary if the

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level is transparent. If the level is transparent, the user would be able to view the target from looking through the level. Therefore, one having ordinary skill in the art would have found the viewing opening between the level and elongated body to be an obvious matter of structural design choice. The structural arrangement as met by the Marshall and the OFFICIAL NOTICE would perform equally as well.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 9 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6716109. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 9 and 10 of the present application does not claim determining a slope. Though claim 9 and 10 does not contain this subject matter, they are anticipated by US Patent 6716109.

### ***Allowable Subject Matter***

Claims 13-17 are allowed.

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Claims 11-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

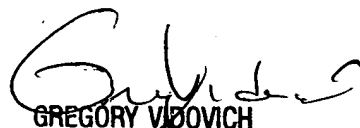
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAN

Alvin A. Hunter, Jr.

  
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